

Appl. No. 10/827,478
Amendment dated 10/26/2007
Reply to Office Action of 09/27/2007

Remarks

The Examiner required restriction under 35 U.S.C. 121, as per item 1 on page 2 of the 09/27/2007 office action, as shown below:

- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-13, drawn to a composition comprising at least one hydrocarbyl functional organopolysiloxane, at least one sunscreen agent, and at least one cosmetic active ingredient, classified in class 424, subclass 401.
 - II. Claims 1-13, drawn to a composition comprising at least one hydrocarbyl functional organopolysiloxane, at least one sunscreen agent, and at least one household care active ingredient, classified in class 510, subclass 108+.
 - III. Claims 1-13, drawn to a composition comprising at least one hydrocarbyl functional organopolysiloxane, at least one sunscreen agent, and at least one health care active ingredient, classified in class 424, subclass 49.
 - IV. Claim 14, drawn to a method of improving the SPF of a sunscreen agent comprising mixing the sunscreen agent with a hydrocarbyl functional organopolysiloxane, classified in class 424, subclass 39.

Applicant respectfully traverses the restriction requirement and submits the Groups I, II, and III as suggested in the 09/27/2007 office action do not properly describe the subject of the claims of the present application. In particular, claim 1 is drawn to two components,

- (i) a hydrocarbyl functional organopolysiloxane comprising a siloxy unit of the formula $R^1 R_a SiO_{(3-a)y/2}$ wherein
R is a monovalent hydrocarbon group,
 R^1 is a hydrocarbyl group having the formula $-R^2OCH_2CH_2OH$,
 R^2 is a divalent hydrocarbon group containing 2 to 6 carbon atoms,
a is zero to 2; and
- (ii) a sunscreen agent.

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Thus, claim 1 does not contain a cosmetic active ingredient, (as per Group I), a household care active ingredient (as per Group II), nor a healthcare active ingredient (as per Group III). Therefore, Applicant believes the Restriction and proposed groupings is not proper.

The Examiner required restriction between product and process claims, as per item 7 on page 4 of the 09/27/2007 office action, as shown below:

7. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a non-elected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In response, Applicant withdraws method claims 13 and 14, but requests these claims be considered for rejoinder and examined for patentability in accordance with 37 CFR 1.104 after prosecution of pending product claims 1 – 10. Applicant respectfully submits withdrawn claim 13 and 14 contain all the limitations of the product claims and therefore considered proper for rejoinder.

The Examiner required an election of species as per items 9 and 10 on page 4 of the 09/27/2007 office action, as shown below:

Election

9. Election of species should be required before a search on the merits in all applications containing both species claims and generic or Markush claims. (MPEP 808.01(a)).

10. Claims 1-3, 5-11, and 13-14 are generic to a plurality of disclosed patentably distinct species comprising: a hydrocarbyl functional organopolysiloxane of Claims 1 and 3, which require a burdensome classification, and/or bibliographic, manual and computer search.

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Applicant traverses the election requirement and respectfully submits the election requirement is not proper for the following reasons.

Applicant submits the Examiner does not properly identify the species to be elected in the 09/27/2007 office action, as discussed in MPEP 809.02(a) section (B).

If the Examiner has interpreted "hydrocarbyl functional organopolysiloxane" as a generic term, (and hence requiring an election to a more species within the genus), Applicant respectfully submits that claim 1 does not recite all "hydrocarbyl functional organopolysiloxane" but is limited by definition of R¹. In other words, claim 1 is not drawn to a genus or plurality of hydrocarbyl groups on an organopolysiloxane.

Should the election of species requirement be maintained, and to comply with the requirements of U.S.C. 121, Applicant elects those hydrocarbyl groups having the structure where R¹ is -(CH₂)₃OCH₂CH₂OH.

Claims 1 – 10 read on this election.

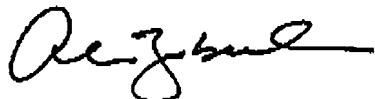
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The present response is being submitted within the one-month shortened statutory period for response to the outstanding Office Action. Applicant authorizes the USPTO to charge deposit account 04-1520 for any fees that should be necessary to maintain the pendency of the application.

In view of the above, it is respectfully submitted that the claims are in condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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